



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/591,336

08/31/2006

David A. Biro

S9025.0345

9426

63725

7590

01/07/2010

DICKSTEIN SHAPIRO
1633 Broadway
NEW YORK, NY 10019

EXAMINER

ROBINSON, CHANCEITY N

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

01/07/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,336	Applicant(s) BIRO ET AL.	
	Examiner CHANCEITY N. ROBINSON	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 19-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2009 has been entered.
2. Claims 1-20 are currently pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1795

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 11-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukui (US 2003/0170576 A1).

Regarding claims 11-14, Fukui discloses a packaging material [0359], which contains less than 700 ppm (600 ppm or 500 ppm) total of residual solvent or water [0384].

Claim 11 is a product-by-process claim. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

7. Claims 11 and 15-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chatterjee et al. (US 6,803,112 A1).

Regarding claims 11 and 15-17, Chatterjee et al. disclose a packaging material (abstract and column 7, lines 64-67) has a degree of cure of at least 5 MEK rubs or 10 MEK rubs or 20 MEK rubs (column 8, lines 1-10).

Claim 11 is a product-by-process claim. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

8. Claim 11-14 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mossbrook et al. (US 2005/0019533A1).

Regarding claims 11-14, Mossbrook et al. disclose that the printed film for packaging (abstract) contains a thermoplastic material in which a product such as food may be introduced into the package and sealed (paragraph [0104]). The package will contain less than 50 ppb (parts by billion) of migratable solvent, which meets the limitation of containing less than 700 ppm (part per million) or 600 ppm or 500 ppm (paragraphs [0007] and [0008]).

Claim 11 is a product-by-process claim. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the

Art Unit: 1795

prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

9. Claims 1, 4-9, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bassemir et al. (US 3,552,986).

Regarding claims 1, 4-9, 11 and 18, Bassemir et al. disclose a method of coating or printing untreated polyolefins (col. 1, lines 20-24). It has been found that coating composition and printing inks that are applied to untreated polyolefins has excellent adhesion properties, water-resistance and rub resistance (col. 1, lines 49-68). The compositions and printing inks are useful as containers for food that must be sterilized (printed packaging material). The method of Bassemir et al. comprises applying an liquid ink (activatable liquid ink) to a packaging material (polyolefin substrate; col. 4, lines 11-15), exposing the ink to first actinic radiation (UV light (lamp); col. 4, lines 16-33), applying an energy-curable coating (clear or colored photopolymerizable composition) over the ink (col. 4, line 66 - col. 4, line 8) and curing the coating with second actinic radiation (example 4 and reference claims 9-15 for the method steps). Bassemir et al. disclose the ink can be applied more than once and it is solvent-based. See col. 4, line 74 – col. 5, line 20 and examples. The printed packaging material can be thermoplastic film, foil laminate paper or paper plastic laminate. See col. 4, lines 53-65.

Bassemir et al. do not explicitly disclose the ink is substantially free of curable functionality. However, examiner notes the term “substantially” is a relative term, which has not been defined. Therefore, the term in the claims is indefinite. It would have been obvious to one of ordinary skill in the art to consider the ink of Bassemir et al. to be substantially free of curable functionality, which meets the limitation of the instant application.

Art Unit: 1795

Further regarding claim, 7, Bassemir et al. do not explicitly disclose the energy-curable coating is free of pigment. However, Bassemir et al. recognize that the energy-curable coating can be a clear (energy-curable coating without a pigment) or colored photopolymerizable composition (energy-curable coating with a pigment). See col. 4, lines 66-73. Therefore, it would have been obvious to one of ordinary skill in the art to use a clear energy-curable coating in view of the desired packaging material.

Further regarding claim 18, Bassemir et al. do not explicitly disclose the packing material contains less than 700 ppm total residual solvent or water. Bassemir et al. disclose the printing ink is dried and has excellent printing qualities, that is gloss, grease resistance, dry rub, soap, water resistance and scratch resistance. See col. 5, lines 1-3 and example 1. Examiner notes it would have been obvious that the packaging material of Bassemir et al. would contain less than 700 ppm total residual solvent or water after it is dried in view of water resistance, gloss and dry rub properties, absent any evidence to the contrary.

10. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speer et al. (US 2002/0119295 A1).

Regarding claims 1-11, Speer et al. disclose radiation triggerable oxygen scavenging article (printed packaging material; [0043]) and method to produce the article [0002-0005]. The method of Speer et al. comprises applying an liquid ink (activatable liquid ink) to a packaging material exposing the ink to first actinic radiation (UV light); applying an energy-curable coating (radiation-curable overprint varnish) over the ink [0095] and curing the coating with second actinic radiation (UV light or electron beam; [0084-0085]). See examples and [0064-0066 and 0106]. Speer et al. disclose the ink can be applied more than once and it is solvent-based [0094]

Art Unit: 1795

or water-based [0076]. The printed packaging material can be thermoplastic film, foil laminate paper or paper plastic laminate [0091-0092 and 0096-0097]

Speer et al. do not explicitly disclose the ink is substantially free of curable functionality. However, examiner notes the term “substantially” is a relative term, which has not been defined. Therefore, the term in the claims is indefinite. It would have been obvious to one of ordinary skill in the art to consider Speer et al.’s ink to be substantially free of curable functionality, which meets the limitation of the instant application.

Further regards to claim, 7, Speer et al. do not explicitly disclose the energy-curable coating is free of pigment. However, Speer et al. disclose the radiation-curable overprint varnish can only include monomers and oligomers/prepolymers [0067], which meet the limitation of the instant application of free of pigment as recited by the instant application.

Response to Arguments

10. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. However, Chatterjee et al. (US 6,803,112 A1) and Mossbrook et al. (US 2005/0019533A1) continue to disclose a packaging material as recited in claims 11-17. Therefore, a new 102/103 (a) rejection is made in view of the Chatterjee et al. and Mossbrook et al.

Allowable Subject Matter

11. Claims 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHANCEITY N. ROBINSON whose telephone number is (571)270-3786. The examiner can normally be reached on Monday to Thursday: 7:30 am-6:00 pm eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chanceity N Robinson/
Examiner, Art Unit 1795

/Cynthia H Kelly/
Supervisory Patent Examiner, Art Unit 1795